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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,867	06/01/2001	Peter J. Malnekoff	MAL6115P0011US	2171

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EXAMINER
KEMPER, MELANIE A

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 05/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/871,867	Applicant(s) MALNEKOFF, PETER J.	
	Examiner M Kemper	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 June 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,304,853. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to an automated gemstone evaluation system and method which input the same information, processes the information for an evaluation report and outputs the report.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims fail to particularly point out and distinctly claim the automation steps necessary to carry out the automated method set forth in the preamble. (The method steps do not perform the automated method as stated in the preamble).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-15,18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal, patent number 6,239,867 in view of Newman et al., "A Multimedia Solution to Productivity Gridlock: A Re-Engineered Jewelry Appraisal System at Zale Corporation" MIS Quarterly, v. 18, n. 1, 3/1994.

Aggarwal teaches an input device for receiving gemstone data including cut type, weight, color, clarity, girdle thickness (see at least col. 3, lines 25-65, col. 4, lines 15-40, col. 14, lines 40-65); a processing device for computing a pricing estimate for use in a consumer evaluation report based upon the gemstone data (col. 16, lines 25-40, claims 25-26, 31); and an output device for communicating the report (col. 16, lines 35-40, col. 7, lines 5-10). Aggarwal does not clearly teach receiving predetermined gemstone data supplied by a user, however, a data file is accepted. It would have been obvious to one having ordinary skill in the art at the time of the invention to have inputted predetermined gemstone data in the automated evaluation system of Aggarwal since accepting predetermined data would have been adopted for the intended use of generating a data file of a gemstone or for the intended use of general query of the database for current market price information (col. 16, lines 25-40, claims 31, 34,35). Aggarwal also teaches the report includes a summary description, a remote communication

section, a printer for printing the report, and a display for displaying the report (see at least col. 2, lines 40-60, col. 3, lines 10-15, col. 4, lines 45-55, col. 6, lines 50-60, col. 7, lines 30-40, col. 16, lines 25-45).

Newman teaches inputting predetermined gemstone information into a processing device which looks up the fair market pricing estimate in an index (p. 24-26). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the predetermined gemstone information as in Newman in the system and method of Aggarwal inputting provided information would have saved time over measuring each gemstone feature. It also would have been obvious to have implemented the gem-pricing index as in Newman since this would have been adopted for the intended use of generating the current market price information used for appraisals of Aggarwal. It also would have been obvious to have included a separate price estimate for each of a plurality of types of retail outlets since this would have been adopted for the intended use of providing the market price range provided in Aggarwal/Newman. It also would have been obvious to have the system user be a consumer in order to allow the user to determine updated appraisal information.

7. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal in view of Newman as applied to claims 15 above, and further in view of The Jewelry Judge.

Aggarwal and Newman teach determining a baseline price estimate based on the gemstone and indexing a data structure to determine the baseline price estimate

as shown above. Newman further teaches adjusting the price based on a jeweler pricing adjustment for generating the baseline price estimate (the jeweler can provide a new value). The Jewelry Judge teaches computing an adjustment factor based on cut and color (Stone information screen). It would have been obvious to one having ordinary skill in the art at the time of the invention to have computed an adjustment factor as in The Jewelry Judge since adjustments would have been necessary in order to provide a custom appraisal since the values are based on a table which likely cannot anticipate every stone variation.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "The Real Computer Payoff: part 3" provides a date of at least April 1995 for the Jewelry Judge.

Vig, patent number 5,911,131 teaches an automated appraisal with adjustment factors (fig. 1 and related text).

No Author, "British Online Valuation Service Now Available Here" Irish Times, 7/10/98 (whole document).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Kemper whose telephone number is 703-305-9589. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

M. Kemper

M Kemper
Primary Examiner
Art Unit 3622

MK
May 6, 2002